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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,321	07/18/2003	Bruce A. Raming	31536-DIV1	3273
23589	7590	02/09/2005	EXAMINER	
HOVEY WILLIAMS LLP 2405 GRAND BLVD., SUITE 400 KANSAS CITY, MO 64108			HENDERSON, MARK T	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/623,321	Applicant(s) RAMING, BRUCE A.	
	Examiner Mark T Henderson	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25, 27-35 and 37-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 25, 30-35, 37-45, 48 and 49 is/are allowed.
- 6) ☐ Claim(s) 1, 6-8, 13-17, 22-24, 46, 47, 50 and 51 is/are rejected.
- 7) ☐ Claim(s) 2-5, 9-12, 18-21, 23 and 27-29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Attachment I</u> . |

Art Unit:

DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9306. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1, 8, 17, 25, 29, 34, and 37 have been amended for further examination. Claims 44-51 have been added. Claims 26 and 36 have been canceled. After further consideration, the examiner has withdrawn the allowable subject matter from the previous office action, and a second non-final action has been given.

Art Unit:

Terminal Disclaimer

2. The terminal disclaimer filed on November 8, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent 6,616,189 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Objections

3. Claims 27-29 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 27-29 are dependent on claim 26 which is a canceled claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 47 is rejected under 35 U.S.C. 102(b) as being anticipated by Bartl.

Bartl discloses a label system comprising: a container (Col. 2, lines 37-38) having a face (11) adapted to receive a first sheet or packing list (37 or 47); a first sheet (37 as shown in Attachment I) including a front side (37A) bearing imprinted customer and packing list information, a back side (37B), a leading margin (37C), a trailing margin (37D), first and second side margins (37E); wherein the margins define a first surface area (S1); a first portion (A) of a particular configuration (dimension), not having adhesive (35) on the back side (37B) as stated in Col. 3, lines 3-10; a second portion (B), wherein the adhesive is applied in the configuration on the back side (37B) of the second portion (B); a second sheet (19) separate from and discrete from the first sheet (37), wherein the second sheet includes a face side (19A), a rear side (19B), a leading edge (19C), a trailing edge (19D), first and second side edges (19E), wherein the edges define a second sheet surface area (S2); lines of weakness (17) defining a center section (19C) removable along the lines of weakness from a surrounding border (19F, as seen in Fig. 1); adhesive (Col. 2, lines 37-40 and 53-55) applied to at least (or all) a portion of the rear side (13B) of the border, whereby the second sheet (13) may be placed atop the first sheet (37) and over all the imprinted information with the first sheet; and further wherein the second sheet surface area (S2) is greater (see Fig. 3) than the first sheet surface area (S1), wherein the second sheet (19)

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further includes an additional line of weakness (seen in Fig. 1) extending between side margins (37E) to define a tear strip (first tab) positioned adjacent the center section (19C).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 6-8, 13-17, 22-24, 46, 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartl (5,340,158) in view of Egan (6,273,986).

Bartl discloses a label system comprising: a container (Col. 2, lines 37-38) having a face (11) adapted to receive a first sheet or packing list (37 or 47); a first sheet (37 as shown in Attachment I) including a front side (37A) bearing imprinted customer and packing list information, a back side (37B), a leading margin (37C), a trailing margin (37D), first and second side margins (37E); wherein the margins define a first surface area (S1); a first portion (A) of a particular configuration (dimension), not having adhesive (35) on the back side (37B) as stated in Col. 3, lines 3-10; a second portion (B), wherein the adhesive is applied in the configuration on

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the back side (37B) of the second portion (B); a second sheet (19) separate from and discrete from the first sheet (37), wherein the second sheet includes a face side (19A), a rear side (19B), a leading edge (19C), a trailing edge (19D), first and second side edges (19E), wherein the edges define a second sheet surface area (S2); lines of weakness (17) defining a center section (19C) removable along the lines of weakness from a surrounding border (19F, as seen in Fig. 1); adhesive (Col. 2, lines 37-40 and 53-55) applied to at least (or all) a portion of the rear side (13B) of the border, whereby the second sheet (13) may be placed atop the first sheet (37) and over all the imprinted information with the first sheet; and further wherein the second sheet surface area (S2) is greater (see Fig. 3) than the first sheet surface area (S1), wherein the second sheet (19) further includes an additional line of weakness (seen in Fig. 1) extending between side margins (37E) to define a tear strip (first tab) positioned adjacent the center section (19C). Bartl further discloses in Fig. 5, wherein the first sheet (47) covers a third label sheet (51).

However, Bartl does not disclose a second sheet having a segment being imperforate to hide all imprinted matter on the first sheet; wherein the first sheet further comprises scannable indicia on the front face and wherein the second sheet includes scannable indicia on the face side corresponding to the scannable indicia on the first sheet; wherein the container has scannable indicia; and wherein the third sheet is a return label.

Egan discloses in Fig. 1, 2, a second sheet (14) having a opaque segment being imperforate to hide any indicia printed on the first sheet (12) as seen in Fig. 1 and 2. Egan further discloses scannable indicia (16 and 32) on the first and second sheet (see Fig. 2); and wherein the

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container can comprises indicia thereon (however, not directly, but through a third label having scannable indicia (Col. 6, lines 5-10).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bartl's labels system with a second sheet having an imperforate opaque to hide indicia on a first sheet placed underneath, and wherein the first sheet or packing list, second sheet or shipping label, and container comprises scannable indicia as taught by Egan for the purpose of providing more security of the information placed on the covered first sheet, and a verification alternative.

In regards to **Claim 50** wherein a third sheet is capable of being a return label, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the third label sheet of the Bartl reference is capable of being a return label.

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Allowable Subject Matter

6. Claims 25, 30-35, 37-45, 48, and 49 are allowed.
7. Claims 2-5, 9-12, 18-21, 23, and 27-29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed on November 8, 2004 have been fully considered but they are not persuasive.

Bartl in view of Egan is now used to disclose a label system comprising all the elements as stated in the claims and as set forth above. Egan is only recited for disclosing an imperforate and opaque shipping label or second sheet, and for disclosing wherein both the first and second sheet and the container can have scannable indicia, wherein the indicia on the container is not "placed thereon" directly, however, it is placed on through the use of a third label capable of having similar indicia.

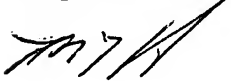
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Prior Art References

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Gruttemeyer et al, Oettinger, Wood et al, Henry et al, and Gullett et al disclose similar label systems.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, a. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

February 2, 2005



**DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700**

FIG. 1

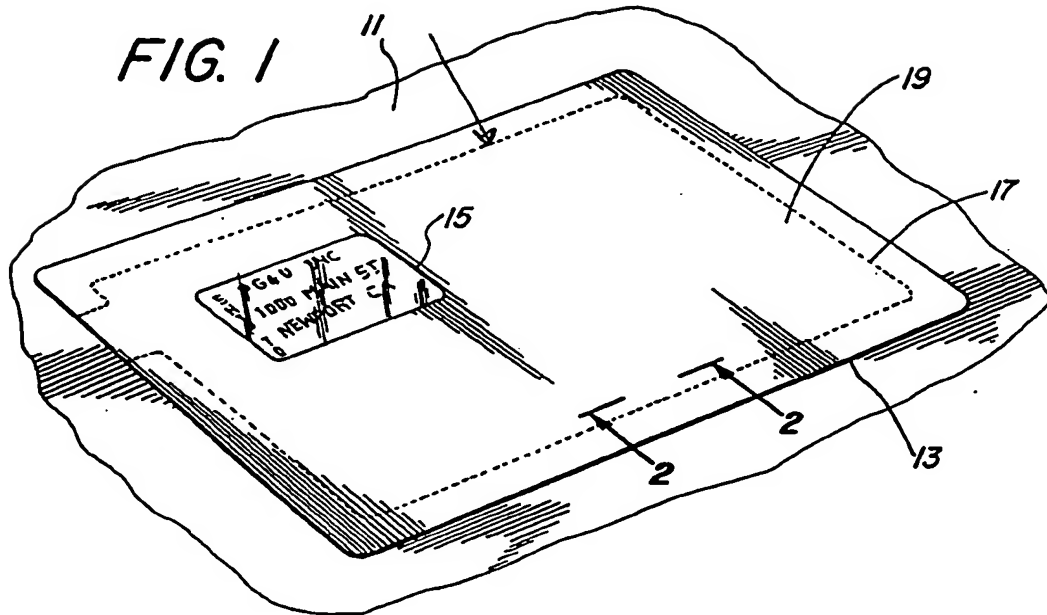


FIG. 2

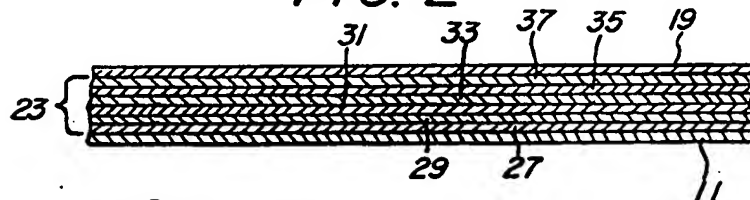


FIG. 3

